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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,509	03/28/2001	Xiaofei Huang	005306.P007	5084

7590

01/24/2005

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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,509

Applicant(s)

HUANG ET AL.

Examiner

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

WCV

DETAILED ACTION

1. This Action is in regards to the Amendment and Response received on 17 August 2004.

Response to Arguments

2. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

3.

Information Disclosure Statement

4. The references listed in the Information Disclosure Statement submitted on 17 August 2004, have been considered by the examiner (see attached PTO-1449).

5. The application has been examined. **Claims 1-30** are pending. The objections and rejections cited are as stated below:

Drawings

6. The informal drawings filed in this application are acceptable for examination purposes.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright et al. (Wright), U.S. Patent No. 5,857,201.

9. Regarding independent claims 1 and 6, (exemplary independent claim 1), Wright discloses a method comprising synchronizing directly a computing device (Wright teaches

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synchronizing databases of the client and server systems [see Wright, items 108, 110, 112, Col. 5, lines 45-59, Col. 6, lines 63-67, Col. 7, lines 1-10] and an enterprise server [see Wright, item 104, Col. 2, lines 23-57] comprising; retrieving a record extraction sequence from the server [see Wright, Col. 9, tables 3 and 4, Col. 10, lines 15-50]; and extracting records stored on a database according to the record extraction sequence, wherein the extracted records are not already stored on the computing device (Wright teaches that the server may insert new data I the database of the client that has been added on the server since the last connection. Furthermore, Wright teaches requesting as well as obtaining records through a remote database API.), [see Wright, Col. 2, lines 62-67, Col. 5, lines 1-67, Col. 6, lines 1-62, Col. 8, lines 20-67, Col. 11, lines 20-67, Col. 12, lines 1-20]. By this rationale claims 1 and 6 are rejected.

10. Regarding dependent claims 2-5 and 7-10, the limitations of these claims are taught within the figures of Wright. Furthermore, with regards to the limitation of logging in to a server [see Wright, Col. 10, lines 65-67 and Col. 11, lines 1-7].

11. Claims 11-20 list all the same elements of claims 1-10, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-10 applies equally as well to claims 11-20.

12. Claims 21-30 all the same elements of claims 1-10, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-10 applies equally as well to claims 21-30.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al. (Wharton), U.S. Patent No. 5,831,664 in view of Hawkins et al. (Hawkins), U.S. Patent No. 6,000,000.

15. Regarding independent claims 1 and 6, (exemplary independent claim 1), Wharton discloses the invention substantially as claimed. Wharton discloses a method comprising synchronizing a computing device and an enterprise server [see Wharton, Col. 1, lines 60-67, Col. 2, lines 1-54, col. 6, lines 19-49]. However, Wharton does not explicitly disclose directly synchronizing and comprising; retrieving a record extraction sequence from the server and extracting records stored on a database according to the record extraction sequence, wherein the extracted records are not already stored on the computing device.

16. In the same field of endeavor, Hawkins discloses (e.g., transferring and synchronizing multiple files between a handheld computer and a personal computer). Hawkins discloses directly synchronizing [see Hawkins, Col. 2, lines 56-67, Col. 3, lines 1-26, Col. 4, lines 26-54, Col. 6, lines 7-55] and comprising; retrieving a record extraction sequence from the server [see Hawkins, Col. 5, lines 14-67]; and extracting records stored on a database according to the record extraction sequence, wherein the extracted records are not already stored on the computing device [see Hawkins, Col. 5, lines 40-67 and Col. 6, lines 1-67].

17. Accordingly, it would have obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Hawkins' teachings of transferring and synchronizing multiple files between a handheld computer and a personal computer with the

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teachings of Wharton, for the purpose of allowing for synchronization between the handheld system and the personal computer system to communicate directly [see Hawkins, Col. 2, lines 40-54]. Thus, Wharton provides motivation to combine by stating there exist a need for an interactive system that allows for a wide range of interfaces to be presented to the user [see Wharton, Col. 1, lines 55-59]. By this rationale claims 1 and 6 are rejected.

18. Regarding dependent claims 2-5 and 7-10, the limitations of these claims are taught within the figures of Wharton-Hawkins.

19. Claims 11-20 list all the same elements of claims 1-10, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-10 applies equally as well to claims 11-20.

20. Claims 21-30 all the same elements of claims 1-10, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-10 applies equally as well to claims 21-30.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim(s) 1-30 of U.S. Patent No. 6,829,655 contain(s) every element of claim(s) 1-30 of the instant application and as such anticipate(s) claim(s) 1-30 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Response to Arguments

22. Applicant's arguments include the failure of previously applied art to expressly disclose retrieving a record extraction sequence from the server. See Response received on 17 August 2004, pages 10-13. It is evident from the detailed mappings found in the above rejection(s) that

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Wright, Wharton and Hawkins, disclose this functionality [see Wright, Col. 2, lines 62-67, Col. 5, lines 1-67, Col. 6, lines 1-62, Col. 8, lines 20-67, Col. 11, lines 20-67, Col. 12, lines 1-20].

Also, Hawkins, further teaches sequentially locate the next altered record utilizing an exact record lookup via SyncReadRecordByID [see Hawkins, Col. 11, lines 409-64]. Further, it is clear from the numerous teachings (previously and currently cited) that the provision for Wright as well as cited prior arts of records, that this was widely implemented in the networking art. It is also, the position of the Examiner that Eventhough Applicant argues retrieving a record extraction sequence. The enabling portion of the specification does not teach record extraction sequence. It states within the specification that an extraction sequence ID is obtained in order to know which database records need to be extracted from the database. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive.

23. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique [see Applicant's enabling portion of the specification on page 17, section 0045 and page 18, sections 0046-0050] . As it is extremely well known in the networking art as already shown by Wright, Wharton and Hawkins and other prior arts of records disclosed, a record extraction sequence from the server as well as other

claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention. The Examiner is attempting to further guide Applicant to areas in which it clearly defines the process of the extraction sequence ID as well as the purpose of comparing and a what point this occurs.

24. Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

25. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

26. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad

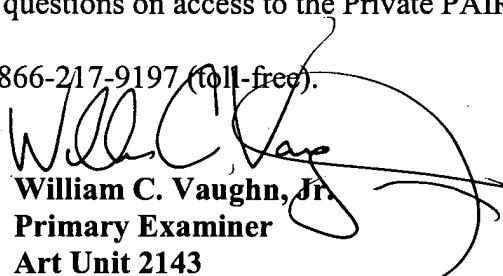
interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Vaughn, Jr.
Primary Examiner
Art Unit 2143

WCV